

REMARKS

After entry of this Amendment, claims 1, 3 and 7-14 will be all the claims pending. Claim 1 has been amended to recite that the ester compound represented by formula (1) is reacted with a ketone compound represented by formula (2) in at least one solvent selected from liquid amide having no hydrogen at the α -position relative to the carbonyl group and liquid urea having no hydrogen at the α -position relative to the carbonyl group. Claims 2, 4-6 and 15-29 have been canceled.

Support for the amendment to claim 1 may be found in original claim 2 and the specification, e.g. at page 14, lines 1-15.

Entry of the above amendments is respectfully requested.

Claim Rejections - 35 U.S.C. § 103(a)

On page 2 of the Office Action, claims 1-29 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Drewes et al. (U.S. Patent No. 5,344,992) and Gordon et al. (Materials Research Society Proceedings, 1998).

Initially, Applicants submit that claims 2, 4-6 and 15-29 have been canceled thereby rendering the rejection moot for these claims.

In response, claim 1 has been amended to recite that the ester compound represented by formula (1) is reacted with a ketone compound represented by formula (2) in at least one solvent selected from liquid amide having no hydrogen at the α -position relative to the carbonyl group and liquid urea having no hydrogen at the α -position relative to the carbonyl group. Applicants submit that the combination of Drewes et al. and Gordon et al. do not teach the method as recite in amended claim 1.

Drewes et al. disclose a process for preparing diketones by reacting a ketone and an ester in a mixture of DMSO and at least one organic solvent which is inert under the reaction conditions which inert solvent is selected from the group consisting of dioxane, tetrahydrofuran, dithylene glycol, dimethyl ether, methyl tert-butyl ether, toluene, and N-methylpyrrolidone. See, claim 1 of Drewes et al.

However, Drewes et al. fail to disclose or suggest that the ester compound is allowed to react with the ketone in at least one solvent selected from liquid amide having no hydrogen at the α -position relative to the carbonyl group and liquid urea having no hydrogen at the α -position relative to the carbonyl group.

Because the reaction is carried out in the specific solvent as recited in amended claim 1, the present invention allows for the preparation of the β -diketone compound in a high yield, as shown in Table 1 in the specification.

In addition, Applicants submit that the β -diketone in Example 1 of Drewes et al. has an aromatic ring and therefore differs from the β -diketone recited in the amended claim 1.

Further, Applicants submit that Gordon et al. do not make up for the deficiencies of Drewes et al. with respect to amended claim 1 and thus, a *prima facie* case of obviousness has not been made because the cited references do not teach or suggest each and every element of the claimed invention.

Applicants further submit that claims 3 and 7-14 are patentable over the cited references for at least the same reasons that amended claim 1 is patentable over the cited references.

Claim Rejections - Double Patenting

On page 5 of the Office Action, claims 1-29 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. patent No. 7,094,306.

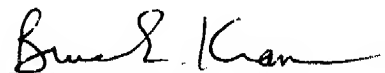
Initially, Applicants submit that claims 2, 4-6 and 15-29 have been canceled thereby rendering the rejection moot for these claims.

In response, and while not admitting that the rejection is appropriate, Applicants submit herewith a terminal disclaimer to obviate this rejection. Accordingly, Applicants submit that this rejection is overcome, and withdrawal of this rejection is respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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